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09/781,253	02/13/2001	Takumi Hasegawa	Q63086	8082

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
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Washington, DC 20037

EXAMINER

DAY, HERNG DER

ART UNIT	PAPER NUMBER
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2128

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	09/781,253		HASEGAWA, TAKUMI	
	Examiner		Art Unit	
	Herng-der Day		2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,9-11,17 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,9-11,17 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's Amendment ("Amendment") to Office Action dated August 11, 2006, mailed November 8, 2006.

1-1. Claims 1, 11, and 17 have been amended. Claims 5-8, 13-16, and 19-20 have been canceled. Claims 27-29 have been added. Claims 1, 2, 4, 9-11, 17, and 23-29 are pending.

1-2. Claims 1, 2, 4, 9-11, 17, and 23-29 have been examined and rejected.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3-1. Claim 27 recites the limitation "said attributes" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 2, 4, 9-11, 17, and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., U.S. Patent 6,414,693 B1 issued July 2, 2002, and filed October 12, 1999.

5-1. Regarding claim 1, Berger et al. disclose a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

correction data receiving means for receiving and storing correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

design assisting means for reflecting said correction data (coordinate location, column 8, lines 6-9) received by said correction data receiving means on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

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a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving means includes

a data base for registering said correction data (the database, column 4, lines 1-5), and

a received mail processing unit for receiving an electronic [mail] to which said correction data is attached and registering and storing said correction data in said data base (the database is organized so that each unique user of the service is defined as an 'entity' 200, column 4, lines 1-5; the customized bag order can be associated with a given client, column 8, lines 2-16),

said received mail processing unit classifying said attached correction data based on an attribute of the user recited in said electronic mail and registering said correction data in said data base based on the classification results (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Although Berger et al. disclose "the image can be submitted for production by clicking the submit button" (column 7, line 67, through column 8, line 2), i.e., an *electronic submission* to which said correction data is included, Berger et al. fail to expressly disclose receiving an *electronic mail* to which said correction data is attached. Nevertheless, using attachment to an electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 1 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

5-2. Regarding claim 2, Berger et al. further disclose wherein said design data is three-dimensional data (for example, 3D bag, Fig. 7).

5-3. Regarding claim 4, Berger et al. further disclose wherein

said editing program file enables editing of three-dimensional data (for example, 3D bag, Fig. 7).

5-4. Regarding claim 9, Berger et al. disclose a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

correction data receiving means for receiving and storing correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

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design assisting means for reflecting said correction data (coordinate location, column 8, lines 6-9) received by said correction data receiving means on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said design data publicizing processing unit includes

information entry selecting means allowing a user to select either information entry in the form of a menu or transfer of said public design data and an editing program file (FIG. 6 provides an information entry selecting means, which allows selection of information entry in the form of a menu, e.g., menu 604, or transfer of public design data and editing program file by clicking other buttons, e.g., 606 and 608).

5-5. Regarding claim 10, in addition to those limitations have already been recited in claim 1, Berger et al. further disclose in creation of said design data by said design assisting means, said

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correction data registered in said data base is used (to maintain its relative location on the bag when reviewed, column 8, lines 2-9).

5-6. Regarding claim 11, Berger et al. disclose a user's request reflecting design method of timely and accurately reflecting users' requests on a product, comprising the steps of:

publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

receiving correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

reflecting said correction data received on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

wherein said design data publicizing step includes the step of

in response to a request from a terminal connected to said computer network, transferring public design data prepared in advance to be publicized among said design data and an editing program file for editing said public design data to said terminal (By clicking both buttons 606 and 608, the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving step including the steps of

receiving an electronic [mail] to which said correction data is attached (the image can be submitted for production by clicking the submit button, column 7, line 67, through column 8, line 2), and

classifying said attached correction data based on an attribute of a user recited in said electronic mail and registering said correction data in a data base based on said classification

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results (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Although Berger et al. disclose "the image can be submitted for production by clicking the submit button" (column 7, line 67, through column 8, line 2), i.e., an *electronic submission* to which said correction data is included, Berger et al. fail to expressly disclose receiving an *electronic mail* to which said correction data is attached. Nevertheless, using attachment to an electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 11 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

5-7. Regarding claim 17, Berger et al. disclose a server of a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47); and

correction data receiving means for receiving correction data as said design data corrected by a user through said computer network and storing said correction data (the selected

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GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9) so as to be usable by design assisting means for reflecting said correction data on product design (to maintain its relative location on the bag when reviewed, column 8, lines 2-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving means includes

a data base for registering said correction data (the database, column 4, lines 1-5), and

a received mail processing unit for receiving an electronic [mail] to which said correction data is attached and registering and storing said correction data in said data base (the database is organized so that each unique user of the service is defined as an 'entity' 200, column 4, lines 1-5; the customized bag order can be associated with a given client, column 8, lines 2-16),

said received mail processing unit classifying said attached correction data based on an attribute of a user recited in said electronic mail and registering said correction data in said data

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base based on said classification results (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Although Berger et al. disclose “the image can be submitted for production by clicking the submit button” (column 7, line 67, through column 8, line 2), i.e., an *electronic submission* to which said correction data is included, Berger et al. fail to expressly disclose receiving an *electronic mail* to which said correction data is attached. Nevertheless, using attachment to an electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 17 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

5-8. Regarding claim 23, Berger et al. disclose a server of a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47); and

correction data receiving means for receiving correction data as said design data corrected by a user through said computer network and storing said correction data (the selected

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GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9) so as to be usable by design assisting means for reflecting said correction data on product design (to maintain its relative location on the bag when reviewed, column 8, lines 2-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52),

wherein said design data publicizing processing unit includes

information entry selecting means allowing a user to select either information entry in the form of a menu or transfer of said public design data and said editing program file (FIG. 6 provides an information entry selecting means, which allows selection of information entry in the form of a menu, e.g., menu 604, or transfer of public design data and editing program file by clicking other buttons, e.g., 606 and 608).

5-9. Regarding claim 24, Berger et al. further disclose wherein

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an electronic mail, to which said correction data is attached, is received at said correction data receiving means, said electronic mail comprising personal information of the user (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

5-10. Regarding claim 25, Berger et al. further disclose comprising:

receiving an electronic mail to which said correction data is attached, said electronic mail comprising personal information of the user (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

5-11. Regarding claim 26, Berger et al. further disclose:

an electronic mail, to which said correction data is attached, is received at said correction data receiving means, said electronic mail comprising personal information of the user (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

5-12. Regarding claim 27, Berger et al. further disclose wherein said attributes are common to a group of users (the order can be associated with a given client, column 8, lines 2-16; if the client is a distributor it represent a group of end users).

5-13. Regarding claim 28, Berger et al. further disclose wherein said correction data is classified according to at least two attributes (This order database can include profile data as well as entity data so that the order can be associated with a given client, column 8, lines 2-16; use entity data for classifying distributors and use profile data for classifying end users).

5-14. Regarding claim 29, Berger et al. further disclose comprising the step of searching the correction data based upon the classified attribute (confirmed by return e-mail, column 8, lines 2-16).

Applicant's Arguments

6. Applicant argues the following:

(1) "Berger does not teach or suggest at least classifying the correction data based on attributes of the user recited in the electronic mail and then registering the correction data in the data base based on the clarification results. Nor does the reference suggest the claimed combination as a whole." (page 10, paragraph 1, Amendment).

(2) "Berger does not teach or suggest at least a menu that would allow the user to enter design information without downloading public design data." (page 11, paragraph 1, Amendment).

Response to Arguments

7. Applicant's arguments have been fully considered.

7-1. Applicant's argument (1) is not persuasive. Berger et al. do suggest the database is organized so that *each unique user* of the service is defined as an 'entity' 200 (Berger, column 4, lines 1-5) and *the customized bag order can be associated with a given client* and confirmed by return e-mail (Berger, column 8, lines 2-16), which meet the recited limitation "classifying said attached correction data based on an attribute of the user recited in said electronic mail and registering said correction data in said data base based on the classification results".

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Furthermore, using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as also evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

7-2. Applicant's argument (2) is not persuasive. In fact, FIG. 6 does provide an information entry selecting means, which allows selection of information entry in the form of a menu, e.g., menu 604, or transfer of public design data and editing program file by clicking other buttons, e.g., 606 and 608. In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., to enter *design* information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kamini S. Shah can be reached on (571) 272-2279. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day

January 8, 2007 *H.D.*


KAMINI SHAH
SUPERVISORY PATENT EXAMINER